1731

MAIL STOP
AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	J.E. Sealey II, et al.	Attorney Docket No.:	23441B
Application No.:	09/975,670	Art Unit: 1731 / Confirmation No.:	9294
Filed:	October 10, 2001	Examiner:	E.J. Hug

Title: PROCESS FOR MAKING A COMPOSITION FOR CONVERSION TO LYOCELL FIBER FROM AN ALKALINE PULP HAVING LOW AVERAGE DEGREE OF POLYMERIZATION VALUES

RESPONSE TRANSMITTAL LETTER

Seattle, Washington 98101
January 11, 2006

TO THE COMMISSIONER FOR PATENTS:

A. Response Transmittal

Transmitted herewith is a response to an Office Action in the above-identified application. No additional claim fee is required.

B. Additional Fee Charges or Credit for Overpayment

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.18 which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. This authorization also hereby includes a request for any extensions of time of the appropriate length required upon the filing of any reply during the entire prosecution of this application.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS[PLLC]

Laura A. Cruz
Registration No. 46,649
Direct Dial No. 206.695.1725

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: January 11, 2006

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RESPONSE

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TO THE COMMISSIONER FOR PATENTS:

This paper is filed in response to the Office Action mailed on October 11, 2005. Currently, Claims 1-11 are pending in the application. Claims 1-11 have been examined and stand rejected. Reconsideration of Claims 1-11 is respectfully requested.

Continued Examination Under 37 C.F.R. § 1.114

Applicants note with appreciation the indication by the Examiner that the obviousness rejection in view of Sellars et al., as applied in the previous Office Action, has been withdrawn.

The Obviousness-Type Double Patenting Rejection

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of U.S. Patent No. 6,491,788. Applicants respectfully disagree.

A proper obviousness-type double patenting rejection requires that the claim being rejected define an invention that is merely an obvious variation of an invention being claimed in a pending application. In this instance, the claims in the present application are related to a process for making a composition for conversion to a lyocell fiber and lack a step that is recited

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in Claim 1 of U.S. Patent No. 6,491,788. Furthermore, the claims of the '788 patent are related to a process for making lyocell fibers.

This application (09/975,670) and the application that matured into the '788 patent are divisional applications of a common parent, Application No. 09/574,538 (U.S. Patent No. 6,331,354). On or about June 20, 2001, applicants' attorney received a telephone call from Examiner Gray requiring restriction in the '538 application between four groups: Claims 1-18, directed to a pulp; Claims 19-33, directed to a lyocell fiber; Claims 34-43, directed to a process for making a composition for conversion to a lyocell fiber; and Claims 44-52, directed to a process for making lyocell fibers. As a result of the restriction requirement, the present application and the application that matured into the '788 patent were filed. Title 35, § 121 of the U.S. Code states,

> If two or more independent and distinct inventions are claimed in one application, the director may require the application to be restricted to one of the inventions. If the other invention is the subject of a divisional application which complies with the requirements of § 120 of this title, it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

The M.P.E.P. further elaborates on the situations where the prohibition of double patenting rejections under 35 U.S.C. § 121 does not apply:

> (a) The applicant voluntarily files two or more applications without a restriction requirement by the Examiner.

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(b) The claims of the different applications or patents are not consonant with the restriction requirement made by the Examiner, since the claims have been changed in material respects from the claims at the time the requirement was made.

(c) The restriction requirement was written in a manner which made it clear to applicant that the requirement was made subject to the non-allowance of generic or other linking claims and such generic or linking claims are subsequently allowed.

(d) The requirement for restriction was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.

(e) The requirement for restriction was withdrawn by the Examiner before the patent issues.

(f) The claims of the second application are drawn to the same invention as the first application or patent.

M.P.E.P. § 804.01.

Applicants submit that the instant claims cannot be rejected in view of the '788 patent because the claims of the present application are consonant with the claims that were restricted in the restriction requirement made in the '354 patent.

As none of the situations enumerated in the M.P.E.P. applies to the present application, applicants respectfully request the withdrawal of the rejection under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,491,788.

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CONCLUSION

In view of the foregoing remarks, applicants respectfully request a Notice of Allowance. If the Examiner has any further questions or comments, the Examiner is invited to contact the applicants' attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
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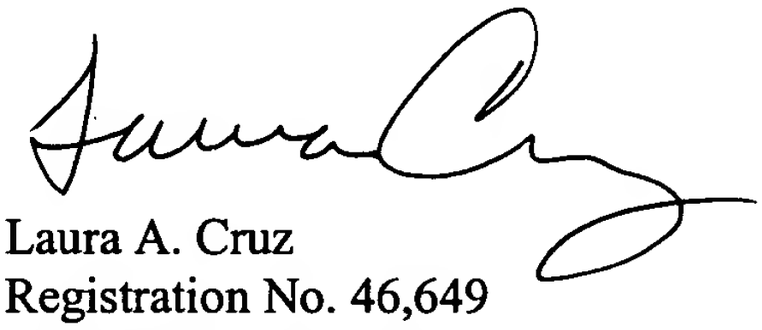

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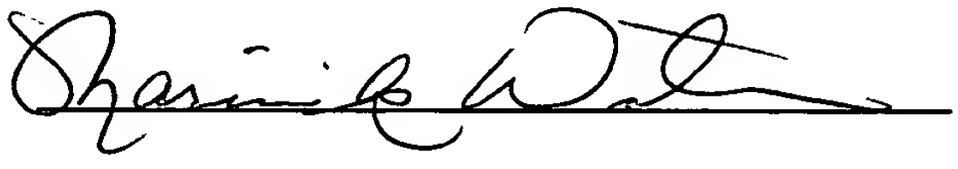

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